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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/757,980

01/13/2004

Rodney Brenneman

021496-000410US

4249

20350

7590

10/18/2006

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EXAMINER

KASZTEJNA, MATTHEW JOHN

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/757,980

Applicant(s)

BRENNEMAN ET AL.

Examiner

Matthew J. Kasztejna

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6, 8-10 and 12-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-10 and 12-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Notice of Amendment*

In response to the amendment filed on January 13, 2006, amended claims 1 and 12-13 and canceled claims 7, 11 and 15-22 are acknowledged. The allowability of claims 5-8 and 11-13 as previously indicated is *withdrawn*. The following new and reiterated grounds of rejection are set forth:

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6, 8, 10, 12 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,800,056 to Tartaglia et al.

**In regard to claims 1, 6, 10, 12 and 14**, Tartaglia et al. teach an endoscope 10 having a steerable distal portion 14 where a guide 36 used to impart a desired curvature is advanced into the steerable distal portion 24 to or near the distal tip of the portion 24 (see Figure 2). As broadly as claimed, the device of Tartaglia et al. is configured to preclude advancement of the guide 36 to the steerable distal portion 24 because it is specifically contemplated that the guide 36 can be inserted to a point that is proximal to the tip of distal portion 24 (see above). Furthermore, as broadly as

Art Unit: 3739

claimed, Tartaglia et al. disclose a hub that precludes advancement of the wire guide (see Col. 10, Lines 29-57). The wire guide also comprises a flexible section that remains flexible when the wire guide is shape-locked, as the tensioning member locks individual segments (see Col. 13, Lines 7-25). **With further respect to claim 10 and in regard to claim 2**, a guide controller 41 is used to selectively rigidize and relax guide 36 during use within a patient (see Col.9, Lines 50-67). **In regard to claims 3 and 4**, guide 36 is slidably disposed within the length of the endoscope body 21 and may freely slide entirely through the passive proximal portion 22, the controllable portion 28 and the steerable distal portion 24 (see Col.9, Lines 40-50).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tartaglia et al. (U.S. Patent Application Publication No. 2002/01200178) in view of Chang (U.S. Patent No. 5,779,624).

**In regard to claim 5**, Tartaglia et al. are silent as to the guide 36 being disposed within an overtube. However, Chang discloses a similar endoscope introduction device comprised of a tubular member 12 that serves as an overtube for a colonoscope 38 (see Figures 5A-5D). Chang thus demonstrates that overtube devices for insertion an endoscope are well known in the art. Accordingly, it would have been obvious for one

Art Unit: 3739

of ordinary skill in the art at the time the invention was made to provide the guide 36 of Tartaglia et al. in an overtube, such as the one disclosed by Chang, as a means for introducing the endoscope. **In regard to claims 9**, Chang teaches an alternate embodiment of tubular member 12 having a slot 62 to removably receive the endoscope 38 (see Figure 6).

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tartaglia et al. (U.S. Patent Application Publication No. 2002/01200178) in view of Chiba et al. (U.S. Patent No. 5,577,992).

**In regard to claim 13**, Tartaglia et al. are silent as to the flexible section comprising a coil spring. Chiba et al. teach of an analogous endoscope having a flexible section with coil spring (see Figs. 1 and 3). It would have been obvious to one skilled in the art at the time the invention was made to include a coil spring in the apparatus of Tartaglia et al. to provide the flexible portion with greater mechanical strength as taught by Chiba et al.

### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

Art Unit: 3739

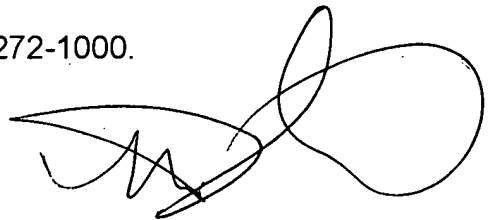
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJK



10/13/06



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SUPERVISORY PATENT EXAMINER  
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